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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,077	11/22/1999	DANA C. BOOKBINDER	16-6-1	3342
22928	7590	12/01/2003		EXAMINER
CORNING INCORPORATED			MARKHAM, WESLEY D	
SP-TI-3-1			ART UNIT	PAPER NUMBER
CORNING, NY 14831			1762	

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

A7

Office Action Summary	Application No.	Applicant(s)	
	09/447,077	BOOKBINDER ET AL.	
	Examiner	Art Unit	
	Wesley D Markham	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 August 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,4,10-12,14,16-21,28,32-53 and 58 is/are pending in the application.
 - 4a) Of the above claim(s) 34-49 is/are withdrawn from consideration.
- 5) Claim(s) 1,2,4,10-12,14,16-21,28,32,33,50-52 and 58 is/are allowed.
- 6) Claim(s) 53 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 02 December 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Response to Amendment

1. Acknowledgement is made of the amendment filed by the applicant on 8/21/2003 in which Claims 32, 33, 50, and 53 were amended, and Claims 27, 29, and 54 – 57 were canceled. Claims 1, 2, 4, 10 – 12, 14, 16 – 21, 28, 32 – 53, and 58 are currently pending in U.S. Application Serial No. 09/447,077 (with claims 34 – 49 being withdrawn without traverse from consideration by the examiner pursuant to a restriction requirement), and an Office Action on the merits follows.

Drawings

2. Acknowledgement is made of the formal drawings (2 figures, 2 sheets) submitted by the applicant with paper #13 on 12/2/2002 (with a certificate of mailing dated 11/26/2002). These formal drawings are approved by the examiner.

Specification

3. The examiner notes that, in the examination of this application, the term "a (silica-containing) article used in the manufacture of an optical fiber" has been interpreted to exclude the optical fiber itself after it has been drawn from a given preform. The term has also been reasonably interpreted to exclude articles such as, for example, glass windows and/or sheets which are not / cannot be "used in the manufacture of an optical fiber".

Claim Objections

4. The objections to Claims 27, 29, 32, and 33, set forth in paragraphs 7 – 8 of the previous Office Action (i.e., the non-final Office Action, paper #20, mailed on 5/19/2003) are withdrawn in light of the applicant's amendment in which Claims 27 and 29 were canceled, and Claims 32 and 33 were amended to correct a typographical error.

Terminal Disclaimer

5. The terminal disclaimer filed on 8/21/2003 (with a certificate of mailing dated 8/19/2003) disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application Number 09/569,562 has been received and reviewed by the examiner. The terminal disclaimer appears to be proper, and as such, the provisional obviousness-type double patenting rejections based on 09/569,562 and set forth in paragraphs 22 – 25 of the previous Office Action are withdrawn. However, the terminal disclaimer has not yet been reviewed by an appropriate paralegal for compliance with all of the formal requirements and has not yet been officially recorded. Therefore, if it is determined that the terminal disclaimer is not proper, the provisional obviousness-type double patenting rejections based on 09/569,562 and set forth in paragraphs 22 – 25 of the previous Office Action will be maintained.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. The rejection of Claims 50 – 57 under 35 U.S.C. 103(a), set forth in paragraphs 13 – 20 of the previous Office Action, are withdrawn for the following reasons: (1) independent Claim 50 (from which Claims 51 and 52 depend) was amended by the applicant to require that the protective layer consist essentially of a silane, and the prior art relied upon by the examiner reasonably suggests incorporating a silane as a release agent into a polymeric protective coating, not that the protective layer consists essentially of a silane, (2) independent Claim 53 was amended by the

applicant to require that the protective layer consist essentially of a wax, an alkyl ammonium compound, or an aryl ammonium compound, and the prior art relied upon by the examiner reasonably suggests incorporating a wax as a release agent into a polymeric protective coating, not that the protective layer consists essentially of a wax, and (3) Claims 54 – 57 were canceled.

9. Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuji et al. (JP 02-258643 A) in view of either Gosset et al. (USPN 4,632,848) or Yamashita et al. (USPN 6,211,282 B1).
10. Tsuji et al. teaches all the limitations of Claim 53 as set forth in paragraphs 7 – 8 of the non-final Office Action (paper #7, mailed on 1/17/2002), except for a method wherein the protective layer consists essentially of an alkyl ammonium compound, an aryl ammonium compound, or a wax. However, Tsuji et al. does teach coating a silica-containing article used in the manufacture of an optical fiber with a temporary / removable resin layer such as a polyester system, polyacryl system, polyvinyl system, polyurethane system, silicone system, etc. to prevent dust and dirt from contaminating the silica-containing article (i.e., preform) (page 5) and to prevent the article from being scratched (page 6, first full paragraph). Gosset et al. teaches that temporary protective coatings that can be applied to an article in order to protect the article from dust, scratching, etc. (i.e., a process analogous to that of Tsuji et al.) include a wax that is dissolved in a suitable solvent and applied to the article by dipping or spraying (Col.1, lines 10 – 12 and 20 – 33, and Col.2, lines 1 – 14). Since

the only component other than wax that is present in the coating composition of Gosset et al. is a solvent that does not appear to materially affect the protective layer once it is applied, the protective layer of Gosset et al. "consists essentially of" a wax, as required by Claim 53. Yamashita et al. (USPN 6,211,282 B1) teaches that glass articles can be temporarily protected from scratching and contamination by applying a strippable coating of paraffin wax dispersed in a solvent to the article (Col.1, lines 7 – 50). Since the only component other than paraffin wax that is present in the coating composition of Yamashita et al. is a solvent that does not appear to materially affect the protective layer once it is applied, the protective layer of Yamashita et al. "consists essentially of" a wax, as required by Claim 53. It would have been obvious to one of ordinary skill in the art to apply a protective layer that consists essentially of a wax (as taught by either Gosset et al. or Yamashita et al.) to the optical fiber preform of Tsuji et al. instead of the protective resin layer taught by Tsuji et al. with the reasonable expectation of success and obtaining similar results (i.e., successfully protecting the glass preform from dust and/or mechanical damage by using a temporary protective coating, regardless of whether the coating consists essentially of a wax or is made of a polymer / resin). Please note that the applicant's specification discloses that the organic material (i.e., the protective layer) can be applied to the glass article by mixing the organic material with water or another solvent and then spraying, wiping, or dipping the article to apply the material (page 7, lines 15 – 19), which supports the examiner's position that a solvent is not excluded from Claim 53 by the "consisting essentially of" language.

Allowable Subject Matter

11. Pending the official acceptance of the terminal disclaimer filed on 8/21/2003, Claims 1, 2, 4, 10 – 12, 14, 16 – 21, 28, 32, 33, 50 – 52, and 58 are allowed.
12. The following is a statement of reasons for the indication of allowable subject matter:

Independent Claims 1 (from which Claims 2, 4, 10 – 12, 14, 16 – 21, 28, 32, and 33 depend) and 58 require that the protective layer coated on the silica-containing article / preform used to manufacture an optical fiber be organic, particulates be removed from the protective layer by cleaning, and the protective layer be ablated (i.e., removed) by heating during subsequent processing of the silica-containing article (e.g., fiber drawing). The prior art of record, alone or in combination, does not teach or reasonably suggest all of the aforementioned claim limitations in the context of independent Claims 1 and 58. Independent Claim 50 (from which Claims 51 and 52 depend) requires that the protective layer consist essentially of a silane. The prior art of record, alone or in combination, does not teach or reasonably suggest this claim limitation in the context of independent Claim 50.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley D Markham whose telephone number is (703) 308-7557. The examiner can normally be reached on Monday - Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

WDM
WDM

Wesley D Markham
Examiner
Art Unit 1762


MICHAEL BARR
PRIMARY EXAMINER